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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,822	12/09/2003	Josef Krummenacher	0115-032299	4354

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EXAMINER

JOHNSON, JERROLD D

ART UNIT PAPER NUMBER

3728

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

Office Action Summary	Application No.	Applicant(s)	
	10/731,822	KRUMMENACHER, JOSEF	
	Examiner	Art Unit	
	Jerrold Johnson	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 15-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>13 May 2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cassette of claim 15; the 6 or 10 tongues of claim 23; and the rib, which separates data carriers of claim 26; must all be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: Page 4, line 26 "fist" should be "first."

Appropriate correction is required.

Claim 15 is objected to because of the following informalities: The first two lines of claim 15 are confusing. The phrase "in a cassette" following "central opening" suggests that the central opening is in the cassette, when in actuality, the central opening is in the data carrier.

Appropriate correction is recommended.

Claim Rejections - 35 USC § 112

Claim 28 recites the limitation "first data carrier". There is insufficient antecedent basis for this limitation in the claim. It is noted that claim 15, from which claim 28 depends, recites, "at least one data carrier." Therefore claim 28 should recite "after insertion of the at least one data carrier..."

Additionally, claim 28 does not positively recite method steps, but instead infers the method steps. Claim 14 is being interpreted as reciting "forming the connecting element in a production process in the first position, and subsequently, at the latest after insertion of the first data carrier, moving the connecting element into the second position for increasing...."

Appropriate correction is required.

Claim Rejections - 35 USC § 102/35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 15-25,27 and 29-33 are rejected under 102(b) as anticipated by Liu EP 0762425 or, in the alternative, under 35 USC 103(a) as obvious over Liu EP 0762425.

Re claim 15, Liu discloses a fastening device for at least one disc shaped data carrier comprising a central opening in a cassette, wherein the cassette comprises a middle part on which a crown of tongues is provided, the crown of tongues 130 is elastically insertable into the central opening of the at least one data carrier, wherein

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there is provided at least one connecting element 134 movably connecting at least two of the tongues.

The claim limitation “wherein the connecting element is produced in the production of the fastening device in a first position, and wherein after the production for increasing the restoring force of the tongues against the data carrier the connecting element is moved into a second position” is being treated as a product by process limitation; that is, that the process of making the connecting element has a step where the connecting element is moved from a first position to a second position. As set forth in MPEP 2113, product by process claims are NOT limited to the manipulations of the recited steps, only to the structure implied by the steps. Once a product appearing to be substantially the same or similar is found, a 35 U.S.C. 102/103 rejection may be made and the burden is shifted to applicant to show an unobvious difference. See MPEP 2113.

Thus, even though Liu is silent as to the process used to make the connecting element, it appears that the product in Liu would be the same or similar as that claimed; especially since the connecting element of the applicant’s product and the prior art product are disposed similarly in their final or “second” position.

Re claim 16, the data carrier can be fastened and removed from the cassette if the connecting element is in its second position.

Re claim 17, opposed tongues are connected with each other by means of the at least one connecting element.

Re claim 18, the tongues comprise at least one axial arm extending through the central opening of the at least one data carrier and wherein the at least one connecting element is attached to the axial arms connecting the axial arms substantially on ends pointing towards the direction of removal of the data carrier.

Re claim 19, the claim limitation "in the first position the connecting element at least partially extends above the ends of the axial arms pointing towards the direction of removal of the data carrier and/or of the radial arms respectively, wherein by means of pressing the connecting element down in the direction of insertion of the data carrier, the connecting element is brought into the second position" further defines the process step of claim 15, and, as set forth in MPEP 2113, this claim is not limited by the process manipulations of the recited steps, only to the structure implied by the steps.

It is understood that the recitation of claim 19 would be construed as a positively recited structural limitation were claim 19 re-drafted to recite "wherein the connecting element is movable from a first position where the connecting element at least partially extends above the ends of the axial arms pointing towards the direction of removal of the data carrier and/or of the radial arms respectively, to a second position where the connecting element is below the ends of the axial arms, and wherein in the second position a restoring force of the tongues against the data carrier is greater than in the first position."

Re claim 20, the connecting element comprises elastic strips (144 on Fig. 6), the elastic strips on one end are connected with the axial arms or radial arms of the tongues, respectively, and wherein the connecting element furthermore comprises a

knob 134 which is substantially located on an axis of symmetry of the fastening device, the strips are connected with their second end to the knob.

Re claim 21, the tongues and the at least one connecting element are one-piece.

Re claim 22, the fastening device is made of a polymeric material (polypropylene), a thermoplastic material in one-component design.

The present application does not state that the a modulus of elasticity E in the range of approximately 1300 to 3200 Mpa is outside the normal range for polypropylene, and instead infers that stock polypropylene is the desired polymeric material for the manufacture of the fastening device.

Accordingly, it is believed that Liu inherently discloses this range, as it is also constructed of polypropylene.

Re claim 23, Liu discloses in Fig. 6 twelve tongues. Tongues with noses for fastening the data carrier alternate with tongues without noses, and wherein either all tongues or only the tongues with noses are connected by means of the connecting element, wherein the connecting element comprises a central uniform part, as well as elastic strips (144 in Fig. 6) branching off from the central uniform part by at least indirectly connecting this central, uniform part with the tongues.

It would have been obvious to one of ordinary skill in the art at the time of the invention to manufacture the fastening device of Liu with fewer tongues, when as few as three tongues have been known to be capable of performing this purpose, and it would require less manufacturing effort to manufacture a mold to produce the fastening device were it to have fewer tongues.

Re claim 24, note slotted holes surrounding the crown of tongues in Fig. 6.

Re claim 25, the disc shaped data carrier is a CD or a DVD.

Re claim 27, the at least one connecting element comprises strips in the form of flexible, flat lamella with a width in the range of approximately 0.8 to 3 mm, and with a thickness of 0.1 to 0.4 mm. Using the diameter of 14 mm as a guide, the strips 144 appear to be within this range.

Re claim 29, the axial arms are connected indirectly by means of inwardly pointing radial arms provided on the ends of the axial arms pointing towards the direction of removal of the data carrier.

Re claim 30, as claim 19, this limitation is construed as further defining the process step of claim 15, and does not further limit the structure of the connecting element in a manner which defines over Liu.

Re claim 31, the connecting element in the second position does not extend above the ends of the axial arms pointing towards the direction of removal of the data carrier and/or of the radial arms respectively.

Re claim 32, Re claim 22, the fastening device is made of a polymeric material (polypropylene), a thermoplastic material in one-component design.

The present application does not state that the a modulus of elasticity E in the range of less than approximately 2000 Mpa is outside the range for polypropylene, and instead infers that stock polypropylene is the desired polymeric material for the manufacture of the fastening device.

Accordingly, it is believed that Liu inherently discloses this range, as it is also constructed of polypropylene.

Re claim 33, using the diameter of 14 mm as a guide, the strips 144 appear to be within this range.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Joyce, Jr US 5,626,225.

Liu does not show the rib for separating discs.

Joyce teaches how a rib 64' can separate discs and keep a controlled distance between data carriers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the fastening device of Liu with the inclusion of a ridge as taught by Joyce so as to permit the fastening device of Liu to accommodate a greater number of discs.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Cerda-Vilaplana et al. US 6,170,656.

The thickness of the strips of Liu is not explicitly stated, although it is identifiable as being less than .5 mm.

Cerda-Vilaplana et al. teaches the use strips having a very thin region 4c so as to accommodate flexibility in this region when the center connecting element 3 is pushed down to remove a disc. This region appears to have a thickness between .2 and .3 mm. It is noted that pushing the center connecting element 3 downward when removing a disc is also the method prescribed by Liu and within the present application.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the fastening device of Liu with the strips having a thickness between .2 and .3 mm, as the thinner strips would flex more and accommodate greater movement of the tongues, resulting in the release of a disc.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch US 5,894,924.

Koch discloses a cassette comprising a middle part on which a crown of tongues 14 is provided, the crown of tongues is elastically insertable into the central opening of the at least one data carrier 1, wherein there is provided at least one connecting element 17 movably connecting at least two of the tongues, wherein the connecting element is produced in the production of the fastening device in a first position, and wherein after the production for increasing the restoring force of the tongues against the data carrier the connecting element is moved into a second position. See column 2, lines 20-25. Additionally, Koch discloses the method of forming the connecting element in a first position and moving it into a second position for increasing the restoring force of the tongues against the data carrier.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerrold Johnson whose telephone number is 571-272-7141. The examiner can normally be reached on 9:30 to 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JDJ



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